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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,475	06/01/2001	Toru Kurokawa	0649-0786P	1027
2292	7590	04/05/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HUNTSINGER, PETER K	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/870,475	Applicant(s) KUROKAWA ET AL.	
	Examiner Peter K. Huntsinger	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/05 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7, 9-13, 15-18, 20, 25, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al. Patent 6,775,023 and further in view of Hirai Patent 6,493,108.

Referring to claims 1, 10, 20, and 29, Fukunaga et al. disclose an image print order system using a network, comprising: an order receiving server which is connected to said network (center server 102 of Fig. 1, col. 5, lines 57-66); and a terminal unit connectable to said network (client computer 101 of Fig. 1, col. 5, lines 42-54), to which a recording medium can be mounted (col. 7, lines 19-26); wherein said terminal unit is connected to said order receiving server based on said server-connection address

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information so as to transmit said designated print-order acceptor information and at least a part of said digital image data at the same time to said order receiving server (col. 19, lines 53-58); and wherein said order receiving server outputs a print command data based on the received digital image data, and a command data by which a receiver of an order in accordance with said designated print-order acceptor information can receive an image print that is printed based on said print command data (col. 6, lines 7-16). Fukunaga et al. disclose storing server-connection address information and designated print order acceptor information in a print order (col. 14, lines 40-48). Fukunaga et al. do not disclose expressly storing the address the server-connection address information and the designated print order acceptor information on a mountable recording medium. Hirai discloses a mountable recording medium storing a digital image data and a print order (Recording Medium 1 of Fig. 1, col. 6, lines 52-61). Fukunaga et al. and Hirai are combinable because they are from the same field of ordering printed photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to provide the print order of Fukunaga et al. on the recording medium of Hirai. The motivation for doing so would have been to allow a customer to use a printing service just by bringing a recording medium and without the need for specifying order information through a memo. Therefore, it would have been obvious to combine Hirai with Fukunaga et al. as specified in claims 1, 10, 20, and 29.

Referring to claims 2, 11, and 17, Fukunaga et al. disclose wherein said order receiving server is a WWW server (col. 6, lines 19-25).

Referring to claims 3, 12, and 18, Fukunaga et al. disclose wherein said server-connection address information and designated print-order acceptant information are URL data for specifying a WWW page created for each receiver of the order (col. 26, lines 34-41), and said terminal unit, after acquiring the data of the WWW page for each of said specified receivers of the order, transmits said digital image data to said WWW server (col. 27, lines 20-24).

Referring to claim 4, Fukunaga et al. disclose wherein data of the WWW page for each of said specified receivers of the order includes data for acquiring data of a WWW page of another receiver than the receiver of the order according to said designated print-order acceptor information (col. 19, lines 53-58).

Referring to claims 7 and 13, Fukunaga et al. disclose said server-connection address information and designated print-order acceptant information (col. 14, lines 40-48). Hirai disclose wherein a print order is recorded when the digital image data is recorded in said recording medium (col. 6, lines 52-61).

Referring to claims 9 and 15, Fukunaga et al. disclose wherein said server-connection address information and said designated print-order acceptant information are renewable (col. 14, lines 40-48).

Referring to claim 16, Fukunaga et al. disclose a recording medium providing method for providing a recording medium on which digital image data have been recorded, there is a step of recording connection address data to a print order receiving server connected to a network, designated print-order acceptor information, and data for causing said terminal unit to connect to said order receiving server through said network

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(col. 14, lines 40-48), and to transmit said digital image data and said designated print-order acceptor information at the same time to said order receiving server (col. 19, lines 53-58). Fukunaga et al. do not disclose expressly scanning developed film or storing the address the server-connection address information and the designated print order acceptor information on a mountable recording medium. Hirai discloses wherein at least one of digital image data obtained by developing a photographic film before development and carrying out a photoelectrical conversion of the image after development, digital image data obtained by carrying out a photoelectrical conversion of the photographic film after development or an image of an image print, and digital image data recorded on other recording mediums is recorded on a single recording medium (col. 1, lines 18-28), and a mountable recording medium storing a digital image data and a print order (Recording Medium 1 of Fig. 1, col. 6, lines 52-61). Fukunaga et al. and Hirai are combinable because they are from the same field of ordering printed photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to provide the print order of Fukunaga et al. on the recording medium of Hirai. The motivation for doing so would have been to allow a customer to use a printing service just by bringing a recording medium and without the need for specifying order information through a memo. Therefore, it would have been obvious to combine Hirai with Fukunaga et al. as specified in claim 16.

Referring to claim 25, Fukunaga et al. disclose wherein the requested service shop originally records its data as the requested service shop data (col. 22, lines 34-41).

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Hirai discloses the recording medium (Recording Medium 1 of Fig. 1, col. 6, lines 52-61).

4. Claims 5-7, 9, 23, 24, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al. Patent 6,775,023 and Hirai Patent 6,493,108, as applied to claims 1-4, and 20 above, and further in view of Fanning et al. Patent 6,742,023.

Referring to claims 5, 23, and 31, Fukunaga et al. disclose sending a print order according to designated print-order acceptor information, but do not disclose expressly accessing an alternative receiver when an acceptor cannot receive the order. Fanning et al. disclose accessing a different server whenever a file cannot be transferred from a server (col. 7, lines 49-65). Fanning et al. disclose the method of accessing a server through FTP (col.7-8, lines 66-68, 1-6), which is a protocol for accessing WWW pages and files. Fukunaga et al. and Fanning et al. are combinable because they are from the same field of electronic file transferring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the image print order system of Fukunaga et al. to access a website of another server whenever a server becomes unavailable. The motivation for doing so would have been to provide an alternative server for file transfer if one server becomes unavailable. Therefore, it would have been obvious to combine Fanning et al. with Fukunaga et al. to obtain the invention as specified in claims 5, 23, and 31.

Referring to claim 6, Fukunaga et al. disclose sending a print order according to designated print-order acceptor information, but do not disclose expressly accessing an alternative receiver when an acceptor cannot receive the order. Fanning et al. disclose accessing a different server whenever a file cannot be transferred from a server (col. 7, lines 49-65). Fukunaga et al. and Fanning et al. are combinable because they are from the same field of electronic file transferring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the image print order system of Fukunaga et al. to access a website of another server whenever a server becomes unavailable. The motivation for doing so would have been to provide an alternative server for file transfer if one server becomes unavailable. Therefore, it would have been obvious to combine Fanning et al. with Fukunaga et al. to obtain the invention as specified in claim 6.

Referring to claim 7, Fukunaga et al. disclose said server-connection address information and designated print-order acceptant information (col. 14, lines 40-48). Hirai disclose wherein a print order is recorded when the digital image data is recorded in said recording medium (col. 6, lines 52-61).

Referring to claim 9, Fukunaga et al. disclose wherein said server-connection address information and said designated print-order acceptant information are renewable (col. 14, lines 40-48).

Referring to claim 24 and 32, Fukunaga et al. disclose wherein the selected print service receiving server is configured to provide to a user of the terminal one or more available service shops capable of fulfilling the print order, and receive the service shop

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chosen by the user from the one or more available service shops (col. 19, lines 53-58).

Fanning et al. disclose determining that the requested server is unavailable (col. 7, lines 49-65).

5. Claims 8, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al. Patent 6,775,023 and Hirai Patent 6,493,108 as applied to claims 1-4 and 10-12 above, and further in view of Fredlund et al. Patent 5,666,215.

Referring to claims 8, 14, and 19, Fukunaga et al. disclose designated print-order acceptor information but do not disclose expressly ordering creation of a CD. Fredlund et al. disclose requesting creation of a CD (col. 2, lines 47-52). Fukunaga et al. and Fredlund et al. are combinable because they are from the same field of ordering printed material. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to order a CD of images. The motivation for doing so would have been to allow a convenient medium on which customers can view their photos. Therefore, it would have been obvious to combine Fredlund et al. with Fukunaga et al. to obtain the invention as specified in claims 8, 14, and 19.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al. Patent 6,775,023, Hirai Patent 6,493,108, and Fanning et al. Patent 6,742,023 as applied to claims 5 above, and further in view of Fredlund et al. Patent 5,666,215.

Referring to claim 8, Fukunaga et al. disclose designated print-order acceptor information but do not disclose expressly ordering creation of a CD. Fredlund et al.

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disclose requesting creation of a CD (col. 2, lines 47-52). Fukunaga et al. and Fredlund et al. are combinable because they are from the same field of ordering printed material. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to order a CD of images. The motivation for doing so would have been to allow a convenient medium on which customers can view their photos. Therefore, it would have been obvious to combine Fredlund et al. with Fukunaga et al. to obtain the invention as specified in claim 8.

7. Claims 21, 22, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al. Patent 6,775,023 and Hirai Patent 6,493,108, as applied to claims 20 and 29 above, and further in view of Subramaniam et al. Patent 6,081,900.

Referring to claims 21 and 30, Fukunaga et al. disclose a print service receiving server but does not disclose expressly transmitting reception data to an alternate shop if it is determined that the service shop is an agency. Subramaniam et al. disclose determining whether a website is to be redirected, and transmitting the data to an alternative website when it is determined that the website is to be redirected (col. 7, lines 1-11). Seeing that the system of Fukunaga et al. utilizes an HTML interface to transmit the reception data, a HTTP redirection would transmit the data to another website, which would be an alternate service shop. The determination of whether the website is an agency is made depending on whether the website redirections the data or not. Fukunaga et al. and Subramaniam et al. are combinable because they are from

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the same field of internet data transferring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to redirect the data to another shop if the requested shop is determined to be a agency. The motivation for doing so would have been to transfer the data to the correct site if the website has been moved.

Therefore, it would have been obvious to combine Subramaniam et al. with Fukunaga et al. to obtain the invention as specified in claims 21 and 30.

Referring to claim 22, Fukunaga et al. disclose the image print ordering system of claim 21, wherein the alternate service shop is configured to deliver a resulting print to the requested service shop (col. 55, lines 20-41).

8. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al. Patent 6,775,023 and Hirai Patent 6,493,108, as applied to claim 20 above, and further in view of Hurtado et al. Patent 6,611,812.

Referring to claim 26, Hirai discloses mounting the recording medium, but does not disclose expressly an automatic run program. Hurtado et al. disclose automatically executing the automatic run program when the recording medium is mounted to the terminal to connect to the selected print service receiving server (col. 84, lines 45-60). Fukunaga et al., Hirai, and Hurtado et al. are combinable because they are from the same field computer systems. At the time of the invention, it would have been obvious to a person of ordinary skill to automatically run a program when a CD is inserted. The motivation for doing so would have been to eliminate the need for the user to manually load the program on the CD. Therefore, it would have been obvious to combine

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Hurtado et al. with Fukunaga et al. and Hirai to obtain the invention as specified in claim 26.

Referring to claim 27, Hurtado et al. disclose the image print ordering system of claim 26, wherein the recording medium further includes a to-network connection program operated by the automatic run program (web browser, col. 84, lines 45-60).

Referring to claim 28, Fukunaga et al. further including a viewer program for viewing and selecting image and generating the print request data. Hurtado et al. disclose the automatic run program (col. 84, lines 45-60).

Conclusion

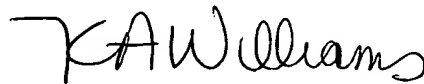
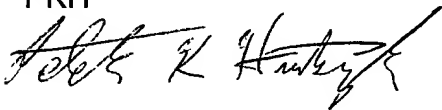
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH



**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**